

Appl. No. 10/627,061  
Amdt. dated May 16, 2005  
Reply to Office Action of February 14, 2005

### **REMARKS/ARGUMENTS**

Applicant's attorney thanks the Examiner for his comments and thoughtful analysis of the present application.

Applicants have amended the Specification to fully set forth the benefit of priority claimed. Applicants have merely clarified that the present application claims priority to the parent U.S. patent application serial number 09/188,358 entitled "Structure Having Balanced pH Profile" filed November 10, 1998, and to the original U.S. patent application serial number 08/989,555 entitled "Structure Having Balanced pH Profile Comprising Acidic Polymer" filed December 12, 1997.

Claims 65-79, 81-92 and 94-97 are presented for the Examiner's consideration. Claims 1-64, 80 and 93 are canceled. Claims 70 and 76 have been amended to replace the word "and" with the word "or." Claims 94-97 are new, and support can be found for Claims 94-97 on page 4, lines 13-17 of the present application.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested.

By way of the Office Action mailed February 14, 2005, the Examiner presented a new Restriction Requirement which replaces the Restriction Requirement mailed December 6, 2004. In response to the original Restriction Requirement mailed December 6, 2004, Applicants provisionally elected the Group V claims with traverse to be prosecuted by way of the present application. That is, Applicants provisionally elected claims 70-74 and 76-79 for prosecution in the present application. It was also noted that claims 65, 69 and 75

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must also be considered with this election since claims 70-74 and 76-79 depend from claims 65, 69 and/or 75.

Applicants also pointed out that with respect to the Examiner's restriction, MPEP §§ 815 and 816 require that the Examiner concisely state the particular reasons relied upon for holding the inventions as claimed as either independent or distinct. Since the Examiner had not set forth sufficient reasoning as to why the groups were patentably distinct from one another, Applicants were not afforded the opportunity to properly traverse the restriction requirement. Therefore, Applicants submitted that the restriction between Group IV, Group V, Group VI, and Group VII was improper and requested that the restriction requirement be withdrawn.

The Examiner has now presented a new, modified Restriction Requirement. However, sufficient support as to why these groups should be considered independent and distinct has still not been provided. For example, no reasoning has been given as to why the limitations of claim 65 are independent and distinct from the limitations of claim 69. Instead, an unsupported conclusionary statement is provided stating that claims 65, 69, 81 and 85 are "*distinct each other and thus they make the absorbent structure distinct at least.*"

In addition, this new Restriction Requirement has been made *final*; however, Applicants have not been given the opportunity to traverse this new restriction. Therefore, Applicants respectfully request that the Examiner remove the finality of this restriction.

In summary, Applicants have been twice restricted now, each time without sufficient reasons as to why a restriction is warranted. In addition, Applicants have not been afforded the opportunity to properly traverse the Restriction Requirement since concise reasons have not been provided as to why the restriction is necessary as required by MPEP §§ 815 and 816. Therefore, Applicants respectfully submit that the new Restriction Requirement between Group I, Group II, Group III and Group IV is improper and request that the Restriction Requirement be withdrawn. Should the finality of this Restriction Requirement be maintained, and without sufficient support for such restriction, Applicants reserve the right to petition the Restriction Requirement.

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However, while Applicants maintain that the Restriction Requirement is improper, Applicants **provisionally elect** Group II of the new Restriction Requirement in order to advance prosecution of the present application. This election is made **WITH TRAVERSE**. Applicants specifically reserve the right to seek patent protection for non-elected subject matter by divisional application.

By way of the Office Action mailed February 14, 2005, the Examiner rejected claims 69 – 79 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-15 of U.S. Patent Number 6,639,120 to Wallajapet et al. To progress prosecution and allowance of the present application, Applicants herewith provide a Terminal Disclaimer to overcome the rejection. The present application and U.S. Patent Number 6,639,120 were subject to an obligation of assignment to Kimberly-Clark Worldwide, Inc. at the time the invention was made.

By way of the Office Action mailed February 14, 2005, the Examiner rejected claims 70 and 76 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

The Examiner states that claims 70 and 76 are confusing because each comprises all of the recited species while each should actually comprise only one specie. The Examiner suggests that replacing the word "and" in claim 70 and claim 76 with the word "or" would resolve the Examiner's confusion. Applicants thank the Examiner for his suggestion and have complied. Thus claim 70 and claim 76 have been amended to replace the word "and" with the word "or."

By way of the Office Action mailed February 14, 2005, the Examiner rejected claims 69, 70 and 73–79 under 35 U.S.C. § 102(b) as allegedly being anticipated by WO

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96/17681 to Palumbo. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

In accordance with MPEP § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

The Examiner has stated in the Office Action mailed February 14, 2005 that Palumbo discloses a Wicking Capacity of 56 g/g in the Table of page 15 which allegedly falls within Applicants' Wicking Capacity claim of at least about 5 g/g. However, it appears that the value disclosed in Palumbo is actually the *Water Retention* value of 56 g/g of Palumbo's Composition E, not the Wicking Capacity of Applicants' claims. It is noted that Wicking Capacity and Water Retention value are two different properties.

Also, the present application discloses an absorbent structure having an upper surface. In contrast, Palumbo does not disclose an absorbent structure having an upper surface. Furthermore, Palumbo requires a cationic superabsorbent polymer in which from 20 to 100% of the functional groups are in basic form, whereas Applicants' invention discloses a *non-polymeric* basic material. In addition, Palumbo does not disclose an absorbent structure that exhibits a Wicking Capacity value that is at least about 5 grams per gram of absorbent structure and that exhibits a pH on the upper surface that remains within the range of about 3 to about 8.

For at least these reasons, Palumbo does not set forth each and every element of Applicants' invention, as required by MPEP § 2131. Applicants respectfully request that this rejection be withdrawn.

By way of the Office Action mailed February 14, 2005, the Examiner alternatively rejected claims 69, 70 and 73-79 under 35 U.S.C. § 103(a) as allegedly being obvious over WO 96/17681 to Palumbo. This rejection is respectfully **traversed** to the extent that it may apply to the presently presented claims.

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In accordance with MPEP § 2142, the Examiner has the burden of establishing a *prima facie* case of obviousness by meeting three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 4899 (Fed. Cir. 1991).

Applicants' invention discloses an absorbent structure having an upper surface. Palumbo does not disclose an absorbent structure having an upper surface. Furthermore, Palumbo requires a cationic superabsorbent polymer in which from 20 to 100% of the functional groups are in basic form, whereas Applicants' invention is directed to a *non-polymeric* basic material. Therefore, Palumbo does not teach or suggest all of the claim limitations of Applicants' invention, as required by MPEP § 2142.

In addition, Palumbo discloses a composition of two components: 1/3 Favor (H+) and 2/3 Fai (OH-) (Composition E listed in the Table of WO 96/17681 on page 15). This composition is similar to Sample 18 of the present application, except that Sample 18 has wood pulp fiber present (see Table 2 of the present application.) If, as suggested, claims 69, 70 and 73 – 79 are obvious over Palumbo, Sample 18 should then demonstrate the claimed properties of the present application (i.e., a combination of a Wicking Capacity of at least 5 grams per gram of absorbent structure and a pH on the upper surface that remains within the range of about 3 to about 8.) However, the results of Sample 18 in Table 3 of the present application indicate that the pH range of this sample is outside of the claimed range (i.e., it is not an example of Applicants' invention.)

Therefore, there is not a reasonable expectation of success, as required by MPEP § 2142, that one of ordinary skill in the art could utilize the teachings of Palumbo to result in Applicants' invention, and the Examiner has not presented reasons to the contrary. Furthermore, the Examiner has provided no teaching or suggestion in Palumbo as to why

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or how one of ordinary skill in the art would utilize the teachings of Palumbo to successfully arrive at Applicants' invention without considering Applicants' disclosure, as required by MPEP § 2124.

For at least these reasons, Applicants submit that the Examiner has not met his burden of establishing a *prima facie* case of obviousness. Applicants respectfully request that this rejection be withdrawn.

By way of the Office Action mailed February 14, 2005, the Examiner rejected claims 69, 70 and 73 – 79 under 35 U.S.C. § 103(a) as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over WO 96/17681 to Palumbo in view of U.S. Publication Number US 2002/0147433 A1 to McOsker et al. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

The McOsker et al. reference, on its face, has an earliest priority date of March 12, 1998. However, since support for rejected claims 69, 70 and 73 – 79 can be found in originally filed U.S. patent application serial number 08/989,555, to which the present application claims priority, the rejected claims thus have an earlier priority date (i.e., December 12, 1997) than McOsker et al. Therefore, McOsker et al. is not available as prior art for this rejection. Applicants respectfully request that this rejection be withdrawn.

By way of the Office Action mailed February 14, 2005, the Examiner rejected claims 69, 70 and 73–79 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent Number 4,833,222 to Siddall et al. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

The present application discloses an absorbent structure having an upper surface. In contrast, Siddall et al. do not disclose an absorbent structure having an upper surface. Furthermore, Siddall et al. disclose a process for the preparation of an absorbent polymeric composition wherein the product of the process is a single component

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neutralized absorbent polymer. In contrast, the present application discloses a multi-component absorbent product comprising 1) acidic water-swellaable, water-insoluble polymer and 2) a non-polymeric basic material. In addition, Siddall et al. do not disclose an absorbent structure that exhibits a Wicking Capacity value that is at least about 5 grams per gram of absorbent structure and that exhibits a pH on the upper surface that remains within the range of about 3 to about 8.

For at least these reasons, Siddall et al. do not set forth each and every element of Applicants' invention, as required by MPEP § 2131. Applicants respectfully request that this rejection be withdrawn.

By way of the Office Action mailed February 14, 2005, the Examiner rejected claims 69, 70 and 73-79 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent Number 4,833,222 to Siddall et al. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

In accordance with MPEP § 2142, the Examiner has the burden of establishing a *prima facie* case of obviousness by meeting three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 4899 (Fed. Cir. 1991).

Applicants' invention discloses an absorbent structure having an upper surface. Siddall et al. do not disclose an absorbent structure having an upper surface. Furthermore, Siddall et al. disclose a process for the preparation of an absorbent polymeric composition wherein the product of the process is a single component neutralized absorbent polymer, whereas the present application discloses a multi-component absorbent product comprising 1) acidic water-swellaable, water-insoluble

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polymer and 2) a non-polymeric basic material. In addition, Siddall et al. do not disclose an absorbent structure that exhibits a Wicking Capacity value that is at least about 5 grams per gram of absorbent structure and that exhibits a pH on the upper surface that remains within the range of about 3 to about 8.

Therefore, Siddall et al. do not teach or suggest all of the claim limitations of Applicants' invention, as required by MPEP § 2142. Furthermore, the Examiner has provided no teaching or suggestion in Siddall et al. as to why or how one of ordinary skill in the art would utilize the teachings of Siddall et al. to successfully arrive at Applicants' invention without considering Applicants' disclosure, as required by MPEP § 2124.

For at least these reasons, Applicants submit that the Examiner has not met his burden of establishing a *prima facie* case of obviousness. Applicants respectfully request that this rejection be withdrawn.

By way of the Office Action mailed February 14, 2005, the Examiner rejected claims 69 – 79 under 35 U.S.C. § 103(a) as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 4,833,222 to Siddell et al. in view of U.S. Publication Number US 2002/0147433 A1 to McOsker et al. and in further view of U.S. Publication Number US 2002/0058097 A1 to Beyer et al. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

The McOsker et al. reference, on its face, has an earliest priority date of March 12, 1998. The Beyer et al. reference, on its face, has an earliest priority date of February 16, 1998. However, since support for rejected claims 69, 70 and 73 – 79 can be found in originally filed U.S. patent application serial number 08/989,555, to which the present application claims priority, the rejected claims thus have an earlier priority date (i.e., December 12, 1997) than McOsker et al. and Beyer et al. Therefore, McOsker et al. and Beyer et al. are not available as prior art for this rejection. Applicants respectfully request that this rejection be withdrawn.



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For at least the reasons stated above, it is respectfully submitted that all of the presently presented claims are in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-4405.

Respectfully submitted,

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#### CERTIFICATE OF TRANSMISSION

I, Bryan R. Rosiejka, hereby certify that on May 16, 2005 this document is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306.

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